

REMARKS

Claim 10 has been amended. Applicant reserves the right to pursue the claim in its pre-amended form in this or other applications. Attached hereto is a marked-up version of the changes made to the claim by the current amendment. The attached page is captioned "Version with markings to show changes made." Claims 1-22 are pending in this application.

Claims 1-4 and 8 stand rejected under 35 U.S.C. 102 as being anticipated by Smith. This rejection is respectfully traversed for the reasons that follow.

Smith does not disclose or suggest a communication system comprising a mobile device having a personal organizer. The Office Action asserts that Smith teaches a "mobile device (12) containing a wireless telephone unit ... and a personal organizer unit (inherent feature of personal or portable computer ...)." The Applicant wishes to point out that, as claimed, the present invention recites a personal organizer unit contained in a mobile device that is separable from the base computer, not a personal organizer unit that is a feature of a personal or portable computer. Smith discloses only a mobile telephone 45 that can be connected to a hinged connector 33 of a computer 31.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in the reference. For at least the foregoing reason, Smith fails to anticipate claim 1. Claims 2-9 depend from claim 1 and contain all of the limitations of claim 1 and should be allowable along with claim 1.

Claims 10, 11, 13-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nguyen further in view of Duncan et al., U.S. Patent No.: 5,825,873 (hereinafter "Duncan"). Claim 10 had been amended. Reconsideration of the rejection is requested.

Nguyen is directed toward a stand alone personal communications terminal having in combination a mobile telephone unit and a personal digital assistant. Duncan

discloses an interface between a telephone host and an accessory item such as a headset or a dialing device. Nguyen and Duncan, either alone or combination, fail to disclose or suggest a “remote data transfer system for transferring .. data from a computer base station to [an] organizer unit while said [organizer unit] is remote from the computer base station.” To render a claim obvious, the prior art references must teach or suggest all the claim limitations. In this case, Nguyen and Duncan fail to even contemplate this claim limitation. For this reason alone the references do not render obvious amended claim 10.

Furthermore, there exists no suggestion or motivation to combine the teachings of Nguyen and Duncan. Applicant previously (in Remarks submitted on March 28, 2001) pointed out that Nguyen relates to a stand alone terminal comprising a PDA, a telephone, and a data interface between the two, while Duncan relates to an interface between a telephone and an accessory item of audio telephony equipment. Therefore, Duncan’s disclosure has no applicability to Nguyen’s personal communications terminal because Nguyen’s terminal neither requires nor justifies another data transfer medium. The Examiner disagreed, stating that “Applicant attempts to overcome the combination ... by attacking the references separately,” and adding that one skilled in the art “would be using Duncan’s teaching of implementing a connection between an accessory item and a host over a wireless media while the accessory item and host are separated to modify Nguyen’s data transfer system for sharing information.” Office Action, page 3.

Applicant does not “attack the references separately,” but discusses the teachings of each reference prior to concluding that motivation to combine the teachings does not exist. After all, the suggestion to combine the references “must be ... either in the references themselves or in the knowledge generally available.” MPEP §2143. Because the Examiner has not provided an example of knowledge that is generally available to combine or modify the references, such motivation must be found in the references themselves.

The Office Action suggests that one skilled in the art would be motivated to use “Duncan’s teaching of implementing a connection between an accessory item and a host over a wireless media while the accessory item and the host are separated to modify

Nguyen's data transfer system for sharing information." This combination is not understood by the Applicant. Why would one use any teaching to separate the components of Nguyen? An important aspect of the Nguyen system is that it provides a single unit comprising a mobile phone and a personal digital assistant electronically connected to the mobile phone. Nguyen seeks to provide a "self-contained mobile station capable of operating as a mobile telephone while performing more advanced functions" of a personal digital assistant. See column 1, lines 23-30. Thus, there exists no motivation (none is provided by Duncan) to combine anything with Nguyen that would separate its components. For this reason, in addition to the reasons discussed above, Duncan and Nguyen cannot be combined to render obvious amended claim 10.

Claims 11-15 and 22 depend from claim 10 and contain all of the limitations of claim 10, and are believed to be allowable based on at least these reasons alone.

Claims 16-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Smith. This rejection is respectfully traversed for the following reasons. As discussed in relation to claim 1 above, Smith fails to disclose or suggest a mobile device, separate from the base computer, having a personal organizer. This is an important aspect of the invention of claim 16.

Claims 17-20 depend from claim 16 and contain all of the limitations of claim 16, and are believed to be allowable based on at least the reasons for allowance of claim 16.

Claim 16 stands rejected under 35 U.S.C. §103 as being unpatentable over Smith in view of Kaufman. This rejection is traversed for the following reasons. As discussed above, Smith does not teach or suggest a handset, remote from a base computer, capable of being used as a personal organizer and a wireless phone. Kaufman does not remedy this deficiency. To render a claim obvious, the prior art must teach or suggest all the claim limitations. In this case, Smith and Kaufman do not. For at least this reason, claim 16 is believed to be allowable over the cited references.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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Version With Markings to Show Changes Made

10. (Twice Amended) A mobile communication handset, said handset comprising:

a personal organizer unit including organizer data access keys and a display screen; and

a remote data transfer system for transferring organizer data from a computer base station to said organizer unit while said handset is remote from the computer base station.